

Notice of Allowability

Application No.

10/644,938

Examiner

Janis L. Dote

Applicant(s)

SUGIURA ET AL.

Art Unit

1756

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Aug. 31, 2006.
2. ☒ The allowed claim(s) is/are 1-6 and 10-22.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

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1. The examiner acknowledges the amendments to claims 15-20 set forth in the amendment filed on Aug. 31, 2006, after the final rejection, which has been entered. Claims 1-6 and 10-22 are pending.

EXAMINER'S AMENDMENT

2. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Ms. Kirsten Grueneberg (Reg. No. 47,297) on Sep. 12, 2006.

The application has been amended as follows:

In claim 3, line 2, delete the marking "a".

In claim 5, line 2, delete the marking "a".

In the amended paragraphs in the specification, filed on Aug. 31, 2006, beginning at: (1) page 82, line 10; (2) page 89, line 4; (3) page 90, line 3; and (4) page 91, line 2, in each instance at lines 2-3 of the paragraphs, delete the phrase "ULTRA VISCO MILL, Aimex" and insert the phrase -- ultra bead mill, Imex --.

At page 75, line 5, of the specification, delete the phrase "Scotch tape" and insert the phrase -- SCOTCH TAPE --.

3. The examiner's amendment to claims 3 and 5 set forth in paragraph 2, supra, removes "markings" that should have been removed when the claims were reproduced in the listing of claims filed on Aug. 31, 2006.

The examiner's amendment to the amended paragraphs in the specification filed on Aug. 31, 2006, avoids an objection to the specification under 35 U.S.C. 132 for the introduction of "new matter" in the disclosure.

The examiner's amendment to the specification at page 75 capitalizes the trademark disclosed on that page to respect the proprietary nature of the mark.

REASONS FOR ALLOWANCE

4. The following is an examiner's statement of reasons for allowance:

The objection to the specification set forth in the office action mailed on Jun. 12, 2006, paragraph 5, has been withdrawn in response to the amended paragraphs at pages 45, 81, 93, and 94, of the specification, filed on Aug. 31, 2006; and in

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response to the examiner's amendment at page 75 of the specification set forth in paragraph 2, supra.

The rejections of claims 15, 20, and 21 under 35 U.S.C. 102(b)/103(a) over US 2002/0081510 A1 (Sugiyama), as evidenced by applicants' admission I, and of claims 16-19 under 35 U.S.C. 103(a) over US 2003/00118366 A1 (Nukada) combined with Sugiyama, as evidenced by applicants' admission I, set forth in the office action mailed on Jun. 12, 2006, paragraphs 7 and 8, respectively, have in response to the amendments to independent claims 15-21 filed on Aug. 31, 2006. Those amendments to claims 15-21 added the limitation of cancelled claim 9 that "a ratio (S/V) of the surface concentration of nitrogen S [of the toner] to the overall concentration of nitrogen V [in the toner] is from 1.2 to 10." As discussed in the office action mailed on Jun. 12, 2006, paragraph 4, the Rule 132 declaration, which was executed by Hideki Sugiura on Dec. 20, 2005, filed on Jan. 6, 2006, shows that the toner in example 14 of Sugiyama has a ratio (S/V) of 1.1, which is outside the scope of the S/V ratio of 1.2 to 10 recited in the instant claims. Accordingly, for the reasons discussed by applicants in the response filed on Jan. 6, 2006, the toner recited in instant claims 15-21 is neither anticipated by nor obvious over Sugiyama.

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The rejections of claims 15-18, 20, and 21 under 35 U.S.C. 102(a)/103(a) over US 2003/0138717 A1 (Yagi), as evidenced by applicants' admissions II; of claims 15-18, 20, and 21 under 35 U.S.C. 102(e) over Yagi, as evidenced by applicants' admission II; and of claim 19 under 35 U.S.C. 103(a) as being unpatentable over Nukada combined with Yagi, as evidenced by applicants' admission II, set forth in the office action mailed on Jun. 12, 2006, paragraphs 9 and 10, respectively, have been withdrawn in response to the amendments to independent claims 15-21 filed on Aug. 31, 2006, as described supra. As discussed in the office action mailed on Jun. 12, 2006, paragraph 4, the Rule 132 declaration filed on Jan. 6, 2006, shows that the toner in example 1 of Yagi has a ratio (S/V) of 1.1, which is outside the scope of the S/V ratio of 1.2 to 10 recited in the instant claims. Accordingly, for the reasons discussed by applicants in the response filed on Jan. 6, 2006, the toner recited in instant claims 15-21 is neither anticipated by nor obvious over Yagi.

The rejections of claims 15-18, 20, and 21 under 35 U.S.C. 102(a)/103(a) over US 2003/0104297 A1 (Matsuda), as evidenced by applicants' admission III; of claims 15-18, 20, and 21 under 35 U.S.C. 102(e) over Matsuda, as evidenced by applicants' admission III; and of claim 19 under 35 U.S.C.

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103(a) over Nukada combined with Matsuda, as evidenced by applicants' admission III, set forth in the office action mailed on Jun. 12, 2006, paragraphs 11 and 12, respectively, have been withdrawn in response to the amendments to independent claims 15-21, as described supra. As discussed in the office action mailed on Jun. 12, 2006, paragraph 4, the Rule 132 declaration filed on Jan. 6, 2006, shows that toner 13 in Matsuda has a ratio (S/V) of 1.1, which is outside the scope of the S/V ratio of 1.2 to 10 recited in instant claims 15-21. Accordingly, for the reasons discussed by applicants in the response filed on Jan. 6, 2006, the toner recited in instant claims 15-21 is neither anticipated by nor obvious over Matsuda.

Claims 1-6 and 10-22 are allowable over the prior art for the reasons discussed above and in the office action mailed on Jun. 12, 2006, paragraph 4, which are incorporated herein by reference.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L. Dote whose telephone number is (571) 272-1382. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mark Huff, can be reached on (571) 272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry regarding papers not received regarding this communication or earlier communications should be directed to Supervisory Application Examiner Ms. Claudia Sullivan, whose telephone number is (571) 272-1052.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JLD
Sep. 12, 2006

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